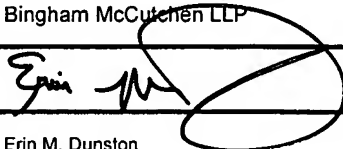


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<b>OFFICIAL TRANSMITTAL FORM</b> MAY 02 2008 PATENT & TRADEMARK OFFICE be used for all correspondence after initial filing	Application Number	10/821,763
	Filing Date	April 9, 2004
	First Named Inventor	Robert WINSKOWICZ
	Art Unit	3711
	Examiner Name	Raeann Trimiew
Attorney Docket Number		705191-2001

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Response to Notification of Non-Compliance with the Requirements of 37 C.F.R. § 41.37(c) <input checked="" type="checkbox"/> Copy of Appeal Brief Pursuant to 37 C.F.R. § 41.37 filed February 4, 2008, including Evidence Appendix containing USPN 6,358,160 and Figures 5 and 6 from USSN 10/821,763 <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Notice of Appeal <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Formal Drawing(s) (      sheets) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition to Correct Inventorship <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) ____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b>  		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Bingham McCutchen LLP		
Signature			
Printed Name	Erin M. Dunston		
Date	May 2, 2008	Reg. No.	51,147

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	<b>MAIL STOP APPEAL BRIEF-</b>
	)	<b>PATENTS</b>
Robert WINSKOWICZ <i>et al.</i>	)	
	)	
Application No.: 10/821,763	)	Group Art Unit: 3711
	)	
Filed: April 9, 2004	)	Examiner: Raeann TRIMIEW
	)	
For: GOLF BALL WITH WATER	)	Confirmation No.: 1461
IMMERSION INDICATOR	)	

**RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH THE**  
**REQUIREMENTS OF 37 C.F.R. § 41.37(c)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Appellants received a Notification of Non-Compliance with the Requirements of 37 C.F.R. § 41.37(c) ("the Notice") mailed April 29, 2008. According to the Notice, the evidence section of Appellants' Appeal Brief was not attached.

The evidence section of the Appeal Brief was attached to Appellants' Appeal Brief filed February 4, 2008.

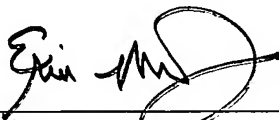
Its omission is likely an Image File Wrapper error. However, to expedite consideration of Appellants' Appeal Brief, Appellants are concurrently refiling the entire Appeal Brief filed on February 4, 2008, including the evidence attachment.

Appellants believe no fees are necessary. However, should any fees be necessary, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-4047.

Respectfully submitted,  
BINGHAM MCCUTCHEN, LLP

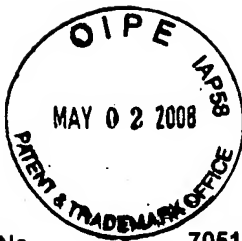
Date: May 2, 2008

By:



Erin M. Durston  
Registration No. 51,147

Bingham McCutchen LLP  
2020 K Street, N.W.  
Washington, D.C. 20006-1806  
Telephone: (202) 373-6162  
Facsimile: (202) 373-6001



Attorney/LAA: Erin M. Dunston  
Due Date: February 3, 2008 (Sunday)  
Date Filed: February 4, 2008

Atty. Docket No. 705191-2001

Re:

Title: Golf Ball With Water Immersion Indicator

Application No.: 10/821,763

Filing Date: April 9, 2004

Patent No.:

Issue Date:

Trademark:

Trademark Reg. No:

Opposition/Cancellation

No:

The following items were received from Bingham McCutchen LLP, Washington, D.C.,  
by the U.S. Patent & Trademark Office:

XX	Transmittal Form
XX	Fee Transmittal
XX	Appeal Brief Pursuant to 37 C.F.R. § 41.37
	789 F.2d 1574, In re Leonard Kaplan and
	Wellington Epler Walker
	Form PTO-1449
	Submission of Formal Drawings
	Request for Corrected Filing Receipt with copy of
	red-lined corrections to Filing Receipt
	Request for Oral Hearing
	Confirmation of Hearing Petition
	Letter Under 37 CFR 1.28 (c)
	Maintenance Fee Transmittal
	TM Statement of Use
	Declaration Under 8
	Declaration Under 8 and 15
	TM renewal Application
	Notice of Opposition
	Supplemental Search Report and
	Annex
	Postcard

#### U.S. PTO FEES

	Assignment Fee
XX	\$255.00 Appeal Fee
	Brief on Appeal Fee
	Oral Hearing Request Fee
	Petition Fee
	Maintenance Fee
	8 Affidavit Fee
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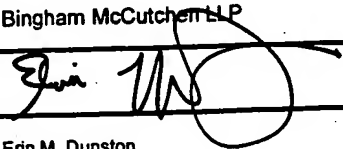
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<b>TRANSMITTAL FORM</b> MAY 02 2008 (to be used for all correspondence after initial filing)	Application Number	10/821,763
	Filing Date	April 9, 2004
	First Named Inventor	Robert WINSKOWICZ
	Art Unit	3711
	Examiner Name	Raeann Trimiew
Attorney Docket Number		705191-2001

## ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Appeal Brief Pursuant to 37 C.F.R. § 41.37 <input checked="" type="checkbox"/> Fee Transmittal <input type="checkbox"/> 2nd Month EOT Request (First Month Paid November 2, 2007) <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Notice of Appeal <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Formal Drawing(s) ( sheets) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition to Correct Inventorship <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b>		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm	Bingham McCutchen LLP		
Signature			
Printed Name	Erin M. Dunston		
Date	February 4, 2008	Reg. No.	51,147

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Effective 12/08/2004.  
 Fees pursuant to the American Inventors' Rights Act, 2011 (H.R. 4818).

# FEE TRANSMITTAL for FY 2006

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 255.00

Complete If Known

Application Number 10/821,763  
 Filing Date April 9, 2004  
 First Named Inventor Robert WINSKOWICZ et al.  
 Examiner Name Raeann Trimiew  
 Art Unit 3711  
 Attorney Docket No. 705191-2001

## METHOD OF PAYMENT (check all that apply)

- ☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) : \_\_\_\_\_
- ☒ Deposit Account Deposit Account Number: 50-4047 Deposit Account Name: Bingham McCutchen LLP
- For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
- ☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
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## FEE CALCULATION

### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

### 2. EXCESS CLAIM FEES

#### Fee Description

Each claim over 20 (including Reissues)  
 Each independent claim over 3 (including Reissues)  
 Multiple dependent claims

Fee (\$)	Fee (\$)
50	25
200	100
360	180
Multiple Dependent Claims	
Fee (\$)	Fee Paid (\$)

Total Claims Extra Claims Fee (\$) Fee Paid (\$)

\_\_\_\_\_ -20 or HP= \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)

\_\_\_\_\_ - 3 or HP= \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$) Fee Paid (\$)

\_\_\_\_\_ - 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

Fees Paid (\$)

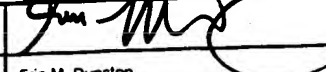
### 4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

\$255.00

Other (e.g., late filing surcharge): Appeal Brief

## SUBMITTED BY

Signature  Registration No. 51,147 Telephone 202-373-6000  
 Name (Print/Type) Erin M. Dunston Date February 4, 2008

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Patent  
Attorney's Docket No.: 705191-2001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

Robert WINSKOWICZ *et al.*

Application No.: 10/821,763

Filed: April 9, 2004

For: GOLF BALL WITH WATER  
IMMERSION INDICATOR

) **MAIL STOP APPEAL BRIEF-**  
) **PATENTS**

) Group Art Unit: 3711

) Examiner: Raeann TRIMIEW

) Confirmation No.: 1461

**APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37**

**MAIL STOP APPEAL BRIEF-PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

Appellants hereby provide their Appeal Brief Pursuant To 37 C.F.R. § 41.37. This

Appeal Brief is accompanied by the fee set forth in 37 C.F.R. § 41.20(b)(2).

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**I. Brief Procedural History**

The instant application, U.S. Patent Application Serial No. 10/821,763 ("the '763 application"), was filed on April 9, 2004. On November 14, 2005, an election of species requirement was issued. *Paper No. 20051108*. In response, Appellants elected species 1, wherein indicia were printed on the surface. *Election filed January 10, 2006*.

On April 5, 2006, an Official Action issued that rejected Claims 1, 3-6, and 10-12 as purportedly anticipated under 35 U.S.C. § 102(e) over U.S. Patent Publication No. 2003/0114245 to Emalfarb ("Emalfarb") because Emalfarb purportedly disclosed "a golf ball comprising an outer layer (applicant's masking layer) that degrades when exposed to water. The layers inherently have a predetermined color and are opaque." *Paper No. 20060403, Page 2*. Claims 2, 7, 8, and 13-30 were objected to, but listed as containing allowable subject matter. *Id.* On September 5, 2006, Appellants filed an Amendment and Response Under 37 C.F.R. § 1.111 that corrected a clerical error in Claim 28 and argued against the anticipation rejection based on Emalfarb. *Amendment and Response Under 37 C.F.R. § 1.111 filed September 5, 2006*.

On November 29, 2006, another Official Action issued. *Paper No. 20061125*. That Official Action indicated that the anticipation rejection over Emalfarb had been overcome, but issued a new anticipation rejection under 35 U.S.C. § 102(b), or, in the alternative, an obviousness rejection under 35 U.S.C. § 103(a), due to U.S. Patent No. 6,358,160 to Winskowicz ("the '160 patent"). *Id. at Page 2*. According to the Examiner, the '160 patent "discloses a golf ball comprising a surface with indicia and a coating (a masking layer) over the surface. Once the coating is penetrated the indicia will appear on the surface (fig 9). The indicia indicates the ball has been exposed to water and has changed characteristics. With respect to claims 2-5, the coating layer obviously includes all the limitations when exposed to water. The coating layer also includes a water activated binder since it is capable of being penetrated by water." *Id.*

Claims 12, 15, 18-24, 26-28, and 30 were objected to, but listed as containing allowable subject matter. *Id.* On March 29, 2007, Appellants filed an Amendment and Reply Pursuant to 37 C.F.R. § 1.111 that amended independent Claim 1 and dependents Claims 2-4, 6-14, 19-20, and added new Claim 31. *Amendment and Reply Pursuant to 37 C.F.R. § 1.111 filed March 29, 2007, Pages 2-7.* Appellants also argued against the 35 U.S.C. § 102(b)/35 U.S.C. § 103(a) rejection over the '160 patent. *Id. at Pages 9-13.*

On July 2, 2007, a Final Official Action issued that repeated the rejection of Claims 1-11, 13, 14, 16, 17, 25, and 29 under 35 U.S.C. § 102(b)/35 U.S.C. § 103(a) over the '160 patent. *Paper No. 20070621.* The Examiner did not address Appellants arguments, other than to say they were not persuasive. *Id. at Page 3.* The Examiner repeated the rejection, verbatim, that had issued in the prior Official Action. *Id. at Page 2.*

Appellants requested a Personal Interview with the Examiner, which was not granted. The Examiner invited Appellants to file a Response, which would be considered. On November 2, 2007, Appellants filed a Response After Final Rejection Pursuant to 37 C.F.R. § 1.113, which reiterated their arguments against the rejections based on the '160 patent. *Response After Final Rejection Pursuant to 37 C.F.R. § 1.113 filed November 2, 2007, Pages 7-13.* The Examiner issued an Advisory Action mailed November 29, 2007, that stated only that Appellants' "arguments are not persuasive." *Paper No. 20071123, Item 11.*

On December 3, 2007, Appellants filed a Notice of Appeal and Pre-Appeal Brief Request for Review. *Pre-Appeal Brief Request For Review filed December 3, 2007.* On December 31, 2007, the Panel issued its Decision from Pre-Appeal Brief Review that did not address Appellants' arguments, other than to state, on a form, that the "application remains under appeal because there is at least one actual issue for appeal." *Paper No. 20071218, Item 2.* When

Appellants' representative telephoned Supervisory Examiner Kim regarding this Decision, Mr. Kim indicated that Art Unit 3711 typically renders form-based Decisions.

Accordingly, this application is now ripe for appeal.

## **II. Real Party In Interest**

Pursuant to 37 C.F.R. § 41.37(c)(1)(i), the real party in interest for the instant application, U.S. Patent Application Serial No. 10/821,763 ("the '763 application"), is Performance Indicator, LLC.

## **III. Related Appeals And Interferences**

Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), Appellants are aware of no "prior and pending appeals, interferences or judicial proceedings . . . which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal."

Accordingly, Appellants are not providing any decisions as an Appendix to this Brief.

## **IV. Status Of Claims**

Pursuant to 37 C.F.R. § 41.37(c)(1)(iii), Appellants hereby provide a statement of the status of all the claims in the proceeding and identify those claims being appealed:

Claims 1-31 are pending. *See Final Office Action mailed July 2, 2007, Office Action Summary, Item 4; Notice of Panel Decision from Pre-Appeal Brief Review, Item 2.* Claim 31 is allowed. *See Final Office Action mailed July 2, 2007, Office Action Summary, Item 5; Notice of Panel Decision from Pre-Appeal Brief Review, Item 2.* Claims 12, 15, 18-24, 26-28, and 30 are objected to, but would be allowable if rewritten in independent form including all limitations of

the base claim and any intervening claims. *See Final Office Action mailed July 2, 2007, Page 2; Notice of Panel Decision from Pre-Appeal Brief Review, Item 2.* Claims 1-11, 13, 14, 16, 17, 25, and 29 stand rejected. *See Final Office Action mailed July 2, 2007, Office Action Summary, Item 4; Notice of Panel Decision from Pre-Appeal Brief Review, Item 2.*

Accordingly, the Claims being appealed are Claims 1-11, 13, 14, 16, 17, 25, and 29.

**V. Status Of Amendments**

Pursuant to 37 C.F.R. § 41.37(c)(1)(iv), Appellants hereby state that no amendments have been filed subsequent to the final rejection that issued on July 2, 2007.

**VI. Summary Of Claimed Subject Matter**

Pursuant to 37 C.F.R. § 41.37(c)(1)(v), Appellants hereby provide a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference character."

Included within the appealed claims, Claims 1-11, 13, 14, 16, 17, 25, and 29, is only one independent claim, Claim 1. Claim 1 is directed to a method for providing a golf ball with a visual indication that a property has been altered due to the presence of water in the golf ball (*see, e.g., Page 1, Lines 4-7*), comprising applying a water-activated mask that is altered to permit viewing of a covered indicator upon being subjected to water (*see, e.g., Page 1, Lines 8-14*).

"Figure 5 is a diagrammatic illustration of the result of removing an opacification layer from a colored underlying surface, showing the underlying surface exposed to indicate extended

water immersion;" *Page 9, Lines 18-20, of the Specification; Figure 5.* "Figure 6 is a diagrammatic illustration of the utilization of the subject opacification layer over indicia on an underlying surface, with the removal of the opacification layer exposing the indicia;" *Page 10, Lines 1-3, of the Specification; Figure 6.*

#### **VII. Grounds Of Rejection To Be Reviewed On Appeal**

Pursuant to 37 C.F.R. § 41.37(c)(1)(vi), Appellants hereby provide a "concise statement of each ground of rejection presented for review."

Whether U.S. Patent No. 6,358,160 to Winskowicz<sup>1</sup> ("the '160 patent") anticipates Claims 1-11, 13, 14, 16, 17, 25, and 29 under 35 U.S.C. § 102(b) or, in the alternative, renders Claims 1-11, 13, 14, 16, 17, 25, and 29 obvious under 35 U.S.C. § 103(a). *See Final Office Action mailed July 2, 2007, Page 2.*

#### **VIII. Argument**

Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), Appellants hereby provide their contentions "with respect to each ground of rejection presented for review . . . and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on." Each ground of rejection will be treated under a separate heading.

---

<sup>1</sup> Robert T. Winskowicz, the named inventor on the '160 patent, is a co-inventor of the instant application.

A. Rejections Under 35 U.S.C. § 102(b)

Claims 1-11, 13, 14, 16, 17, 25, and 29 stand rejected under 35 U.S.C. § 102(b) as purportedly anticipated by the '160 patent. See *Final Office Action mailed July 2, 2007, Page 2*. This rejection is respectfully traversed.

According to the Examiner, the '160 patent "discloses a golf ball comprising a surface with indicia and a gloss coating (masking layer) over the surface. Once the coating is penetrated the indicia will appear on the surface (fig 9). The indicia indicates the ball has been exposed to water and has changed characteristics. With respect to claims 2-5, the coating layer obviously includes all the limitations when exposed to water. The coating layer also included a water activated binder since it is capable of being penetrated by water." *Final Office Action mailed July 2, 2007, Page 2*.

Appellants note that "[i]nvalidity based on 'anticipation' requires that the invention is not in fact new." *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120 (Fed. Cir. 2002) (quoting *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995)). "A single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art." *Verve*, 311 F.3d at 1120 (citing *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). Put differently, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Appellants assert that the '160 patent fails to set forth each and every element of Claims 1-11, 13, 14, 16, 17, 25, and 29.

1. Claims 1, 6-11, and 13

The Examiner is of the opinion that "the water-activated mask in the ['160 patent] is the glossy coat on the outer layer of the ball. Once the coating is penetrated the indicia appears.

Therefor[e] the glossy coating is equivalent to applicant's masking layer. Also, the claims do not require the masking layer to be opaque." *Final Office Action mailed July 2, 2007, Page 3, First Paragraph.*

Appellants respectfully and completely disagree. The method of Claim 1 requires applying a water-activated mask to a golf ball that *already contains* an indicator. When the golf ball is subjected to water, the mask is activated such that it is altered so as to permit viewing of the underlying, already existing indicator. The method of Claim 1 employs a golf ball that contains an indicator that is already in its final indicator state. The indicator is not initially visible, as it is hidden by a mask. If, however, the golf ball is exposed to water, the mask is activated. Upon activation, the mask is altered to permit viewing of the indicator. The important point is that the indicator does not change. Instead, only the mask, upon being activated by water, changes.

The golf balls claimed in the '160 patent are different from the golf balls employed in Appellants' claimed method 1 because the golf balls in the '160 patent have imprints upon them made with a water-activated ink. Because those imprints are made with water-activated ink, they need not be hidden from view and thus require no masking layer. Should another layer be coated over those imprints the coating need not be opaque and, in fact, may be transparent or clear. Because the imprints are made using water-activated ink, the ink changes upon exposure to water and thus the imprints themselves change in the golf balls in the '160 patent. This stands in stark

contrast to the golf balls employed in Appellants' claimed method 1 whose indicator is already in its final indicator state and does not change upon exposure to water.

Appellants submit that when this fundamental difference between the method of Claim 1 and the invention of the '160 patent is appreciated, it becomes apparent that the '160 patent fails to anticipate Claim 1 because the '160 patent fails to disclose each and every element of Claim 1. Claims 6-11 and 13 depend from Claim 1 (either directly or indirectly), and thus contain all limitations of Claim 1. Accordingly, the '160 patent similarly fails to anticipate Claims 6-11 and 13.

2. Claim 2

Claim 2 depends from Claim 1, and thus includes all limitations of Claim 1. As such, Appellants assert that the '160 patent fails to anticipate Claim 2 at least for the reasons the '160 patent fails to anticipate Claim 1. Moreover, Claim 2 specifies that the mask alteration includes changing the refractive index of the mask. The '160 patent is silent with regard to any such "refractive index." Accordingly, Appellants submit that the '160 patent fails to disclose each and every element of, *i.e.*, anticipate, Claim 2.

3. Claim 3

Claim 3 depends from Claim 1, and thus includes all limitations of Claim 1. As such, Appellants assert that the '160 patent fails to anticipate Claim 3 at least for the reasons the '160 patent fails to anticipate Claim 1. Moreover, Claim 3 specifies that the mask alteration includes at least partial degradation of the mask. While the '160 patent mentions, at Column 10, Lines 9-12, the concept of controlled degradation, it does so with respect to combining water-activated inks with resins to establish precise controlled degradation. Claim 3 does not mandate the use of



a resin to achieve partial degradation of the mask. Accordingly, Appellants submit that the '160 patent fails to disclose each and every element of, *i.e.*, anticipate, Claim 3.

4. Claim 4

Claim 4 depends from Claim 3, which depends from Claim 1, and thus includes all limitations of Claims 1 and 3. As such, Appellants assert that the '160 patent fails to anticipate Claim 4 at least for the reasons the '160 patent fails to anticipate Claims 1 and 3. Moreover, Claim 4 specifies that the partial degradation includes at least a partial sloughing off of the mask. The '160 patent is silent with regard to any such "sloughing off." Accordingly, Appellants submit that the '160 patent fails to disclose each and every element of, *i.e.*, anticipate, Claim 4.

5. Claim 5

Claim 5 depends from Claim 3, which depends from Claim 1, and thus includes all limitations of Claims 1 and 3. As such, Appellants assert that the '160 patent fails to anticipate Claim 5 at least for the reasons the '160 patent fails to anticipate Claims 1 and 3. Moreover, Claim 5 specifies that the partial degradation includes microbial degradation. The '160 patent is silent with regard to any such "microbial degradation." Accordingly, Appellants submit that the '160 patent fails to disclose each and every element of, *i.e.*, anticipate, Claim 5.

6. Claims 14, 25, and 29

Claim 14 depends from Claim 1, and thus includes all limitations of Claim 1. As such, Appellants assert that the '160 patent fails to anticipate Claim 14 at least for the reasons the '160 patent fails to anticipate Claim 1. Moreover, Claim 14 specifies that the mask includes a water-activated binder. The '160 patent is silent with regard to any such "binder." Accordingly, Appellants submit that the '160 patent fails to disclose each and every element of, *i.e.*, anticipate, Claim 14. Claims 25 and 29 depend from Claim 14, and thus contain all limitations of Claim 14.

While the concepts of water degradable polymers and water swellable entities are disclosed in the '160 patent, such concepts are not addressed with regard to the binder of Claim 14.

Accordingly, the '160 patent similarly fails to anticipate Claims 25 and 29.

7. **Claim 16**

Claim 16 depends from Claim 14, which depends from Claim 1, and thus includes all limitations of Claims 1 and 14. As such, Appellants assert that the '160 patent fails to anticipate Claim 16 at least for the reasons the '160 patent fails to anticipate Claims 1 and 14. Moreover, Claim 16 specifies that the binder include bubbles. The '160 patent is silent with regard to any such "bubbles." Accordingly, Appellants submit that the '160 patent fails to disclose each and every element of, *i.e.*, anticipate, Claim 16.

8. **Claim 17**

Claim 17 depends from Claim 14, which depends from Claim 1, and thus includes all limitations of Claims 1 and 14. As such, Appellants assert that the '160 patent fails to anticipate Claim 17 at least for the reasons the '160 patent fails to anticipate Claims 1 and 14. Moreover, Claim 17 specifies that the binder include voids. The '160 patent is silent with regard to any such "voids." Accordingly, Appellants submit that the '160 patent fails to disclose each and every element of, *i.e.*, anticipate, Claim 17.

B. **Rejections Under 35 U.S.C. § 103(a)**

Claims 1-11, 13, 14, 16, 17, 25, and 29 stand rejected under 35 U.S.C. § 103(a) as purportedly obvious in view of the '160 patent. *See Final Office Action mailed July 2, 2007, Page 2.* This rejection is respectfully traversed.

Appellants respectfully submit that a *prima facie* case of obviousness has not been made against Claims 1-11, 13, 14, 16, 17, 25, and 29. Obviousness is a question of law, based upon

several factual inquiries (known as “the *Graham* factors”), including determining (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) whether the differences are such that the claimed invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 660 (Fed. Cir. 2000) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)).

When making an obviousness rejection, Examiners are instructed to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. . . . Factual findings made by Office personnel are the necessary underpinnings to establish obviousness. . . . Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. . . . In short, the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge.” 72(195) Fed. Reg. 57526, at 57527 (Oct. 10, 2007). Examiners bear the initial burden of factually supporting any *prima facie* conclusion of obviousness and if such a case is not made, “the applicant is under no obligation to submit evidence of nonobviousness.”

*M.P.E.P.* § 2142 (noting also that the “key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious”).

Appellants respectfully submit that a *prima facie* case of obviousness as to Claims 1-11, 13, 14, 16, 17, 25, and 29 has not been made. There are no factual findings of record regarding the *Graham* factors. That is, there are no findings regarding: (1) the scope and content of the

prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) whether the differences are such that the claimed invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *See Ruiz*, 234 F.3d at 660.

Accordingly, Appellants believe the obviousness rejection of Claims 1-11, 13, 14, 16, 17, 25, and 29 under 35 U.S.C. § 103(a) should be reversed.

1. Claims 1, 6-11, and 13

The Examiner is of the opinion that “the water-activated mask in the [‘160 patent] is the glossy coat on the outer layer of the ball. Once the coating is penetrated the indicia appears. Therefor[e] the glossy coating is equivalent to applicant’s masking layer. Also, the claims do not require the masking layer to be opaque.” *Final Office Action mailed July 2, 2007, Page 3, First Paragraph.*

Appellants submit that this passage does not explain *why* the invention of Claim 1 would have been obvious to one of skill in the art. The method of Claim 1 requires applying a water-activated mask to a golf ball that *already contains* an indicator. When the golf ball is subjected to water, the mask is activated such that it is altered so as to permit viewing of the underlying, already existing indicator. The method of Claim 1 employs a golf ball that contains an indicator that is already in its final indicator state. The indicator is not initially visible, as it is hidden by a mask. If, however, the golf ball is exposed to water, the mask is activated. Upon activation, the mask is altered to permit viewing of the indicator. The important point is that the indicator does not change. Instead, only the mask, upon being activated by water, changes.

The golf balls claimed in the ‘160 patent are different from the golf balls employed in Appellants’ claimed method 1 because the golf balls in the ‘160 patent have imprints upon them

made with a water-activated ink. Because those imprints are made with water-activated ink, they need not be hidden from view and thus require no masking layer. Should another layer be coated over those imprints the coating need not be opaque and, in fact, may be transparent or clear.

Because the imprints are made using water-activated ink, the ink changes upon exposure to water and thus the imprints themselves change in the golf balls in the '160 patent. This stands in stark contrast to the golf balls employed in Appellants' claimed method 1 whose indicator is already in its final indicator state and does not change upon exposure to water.

Appellants submit that when this fundamental difference between the method of Claim 1 and the invention of the '160 patent is appreciated, it becomes apparent that the '160 patent does not render Claim 1 obvious. Claims 6-11 and 13 depend from Claim 1 (either directly or indirectly), and thus contain all limitations of Claim 1. Accordingly, the '160 patent similarly fails to render Claims 6-11 and 13 obvious.

**2. Claim 2**

Claim 2 depends from Claim 1, and thus includes all limitations of Claim 1. As such, Appellants assert that the '160 patent fails to render Claim 2 obvious at least for the reasons the '160 patent fails to render Claim 1 obvious. Moreover, Claim 2 specifies that the mask alteration includes changing the refractive index of the mask. The '160 patent is silent with regard to any such "refractive index." Accordingly, Appellants submit that the '160 patent does not render Claim 2 obvious.

**3. Claim 3**

Claim 3 depends from Claim 1, and thus includes all limitations of Claim 1. As such, Appellants assert that the '160 patent fails to render Claim 3 obvious at least for the reasons the '160 patent fails to render Claim 1 obvious. Moreover, Claim 3 specifies that the mask alteration

includes at least partial degradation of the mask. While the '160 patent mentions, at Column 10, Lines 9-12, the concept of controlled degradation, it does so with respect to combining water-activated inks with resins to establish precise controlled degradation. Claim 3 does not mandate the use of a resin to achieve partial degradation of the mask. Accordingly, Appellants submit that the '160 patent fails to render Claim 3 obvious.

**4. Claim 4**

Claim 4 depends from Claim 3, which depends from Claim 1, and thus includes all limitations of Claims 1 and 3. As such, Appellants assert that the '160 patent fails to render Claim 4 obvious at least for the reasons the '160 patent fails to render Claims 1 and 3 obvious. Moreover, Claim 4 specifies that the partial degradation includes at least a partial sloughing off of the mask. The '160 patent is silent with regard to any such "sloughing off." Accordingly, Appellants submit that the '160 patent fails to render Claim 4 obvious.

**5. Claim 5**

Claim 5 depends from Claim 3, which depends from Claim 1, and thus includes all limitations of Claims 1 and 3. As such, Appellants assert that the '160 patent fails to render Claim 5 obvious at least for the reasons the '160 patent fails to render Claims 1 and 3 obvious. Moreover, Claim 5 specifies that the partial degradation includes microbial degradation. The '160 patent is silent with regard to any such "microbial degradation." Accordingly, Appellants submit that the '160 patent fails to render Claim 5 obvious.

**6. Claims 14, 25, and 29**

Claim 14 depends from Claim 1, and thus includes all limitations of Claim 1. As such, Appellants assert that the '160 patent fails to render Claim 14 obvious at least for the reasons the '160 patent fails to render Claim 1 obvious. Moreover, Claim 14 specifies that the mask includes

a water-activated binder. The '160 patent is silent with regard to any such "binder."

Accordingly, Appellants submit that the '160 patent fails to render Claim 14 obvious. Claims 25 and 29 depend from Claim 14, and thus contain all limitations of Claim 14. While the concepts of water degradable polymers and water swellable entities are disclosed in the '160 patent, such concepts are not addressed with regard to the binder of Claim 14. Accordingly, the '160 patent similarly fails to render Claims 25 and 29 obvious.

7. Claim 16

Claim 16 depends from Claim 14, which depends from Claim 1, and thus includes all limitations of Claims 1 and 14. As such, Appellants assert that the '160 patent fails to render Claim 16 obvious at least for the reasons the '160 patent fails to render Claims 1 and 14 obvious. Moreover, Claim 16 specifies that the binder include bubbles. The '160 patent is silent with regard to any such "bubbles." Accordingly, Appellants submit that the '160 patent fails to render Claim 16 obvious.

8. Claim 17

Claim 17 depends from Claim 14, which depends from Claim 1, and thus includes all limitations of Claims 1 and 14. As such, Appellants assert that the '160 patent fails to render Claim 17 obvious at least for the reasons the '160 patent fails to render Claims 1 and 14 obvious. Moreover, Claim 17 specifies that the binder include voids. The '160 patent is silent with regard to any such "voids." Accordingly, Appellants submit that the '160 patent fails to render Claim 17 obvious.

IX. Claims Appendix

Pursuant to 37 C.F.R. § 41.37(c)(1)(viii), Appellants append hereto, as Appendix 1, a copy of the claims involved in the appeal.

**X. Evidence Appendix**

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), Appellants append hereto, as Appendix 2, a copy of evidence entered by the Examiner and relied upon by Appellants.

**XI. Related Proceedings Appendix**

Because Appellants are aware of no "prior and pending appeals, interferences or judicial proceedings . . . which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal," Appellants are not, pursuant to 37 C.F.R. § 41.37(c)(1)(x), appending any decisions. *See Section II, supra.*

**XII. Conclusion**

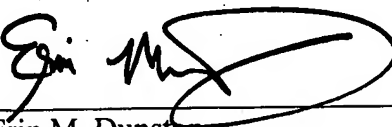
Appellants respectfully submit that the '160 patent fails to anticipate, under 35 U.S.C. § 102(b), Claims 1-11, 13, 14, 16, 17, 25, and 29. Appellants also respectfully submit that the '160 patent fails to render obvious, under 35 U.S.C. § 103(a), Claims 1-11, 13, 14, 16, 17, 25, and 29.

The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4047.

Respectfully submitted,  
BINGHAM MCCUTCHEN, LLP

Date: February 4, 2008

By:

  
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**CLAIMS APPENDIX**

1. A method for providing a golf ball with a visual indication that a property has been altered due to the presence of water in the golf ball, comprising:  
  
applying a water-activated mask that is altered to permit viewing of a covered indicator upon being subjected to water.
2. The method of Claim 1, wherein the mask alteration includes changing the refractive index of the mask.
3. The method of Claim 1, wherein the mask alteration includes at least partial degradation of the mask.
4. The method of Claim 3, wherein the partial degradation includes at least a partial sloughing off of the mask.
5. The method of Claim 3, wherein the partial degradation includes microbial degradation.
6. The method of Claim 1, wherein the covered indicator of the golf ball has a predetermined color.
7. The method of Claim 1, wherein the covered indicator includes indicia.

8. The method of Claim 7, wherein the indicia is a printed indicia.
9. The method of Claim 7, wherein the indicia is an embedded indicia.
10. The method of Claim 1, wherein the mask is at least partially dissolved by water.
11. The method of Claim 1, wherein the mask is at least partially removed in the presence of water.
13. The method of Claim 12, wherein the mask is made at least partially transparent upon water activation.
14. The method of Claim 1, wherein the mask includes a water-activated binder.
16. The method of Claim 14, wherein the binder include bubbles.
17. The method of Claim 14, wherein the binder includes voids.
25. The method of Claim 14, wherein the binder includes a water degradable polymer.
29. The method of Claim 14, wherein the binder is water swellable.

**EVIDENCE APPENDIX**

Appended hereto is a copy of the '160 patent.

Also appended hereto are Figures 5 and 6 from the instant application.

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